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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/829,154 | 04/22/2004 | Takashi Aketa | 0171-1087PUS1 | 5733 |

2292 7590 10/30/2006

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| EXAMINER |
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SCHATZ, CHRISTOPHER

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| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,154

Applicant(s)

AKETA ET AL.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Takuman et al. (EP 1225211) and Simizu et al. '140.

Claims 1-7 and 11 are rejected for the same reasons as set forth in paragraph 2 of the office action dated May 16, 2006.

As to claims 12-17, Simizu discloses a method of using the same amount of aluminum hydroxide powder in relation to the disclosed polydiorganosiloxane. One of ordinary skill in the art thus would have readily understood to use applicant's claim amount of aluminum hydroxide powder in relation to applicant's polyorganosiloxane.

3. Claims 1-7 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Takuman et al. (EP 1225211) and Simizu et al. '140.

Claims 1-7 and 11 are rejected for the same reasons as set forth in paragraph 3 of the office action dated May 16, 2006.

As to claims 12-17, Simizu discloses a method of using the same amount of aluminum hydroxide powder in relation to the disclosed polydiorganosiloxane. One of ordinary skill in the

art thus would have readily understood to use applicant's claim amount of aluminum hydroxide powder in relation to applicant's polyorganosiloxane.

Response to Arguments

Applicant's arguments filed August 16, 2006 have been fully considered but they are not persuasive. With respect to Takuman, applicant states that "aluminum hydroxide powder is not an alternative to calcium carbonate powder for an adhesive used to bond silicone rubber at all." In the office action dated May 16, 2006, examiner takes the position in paragraph 2 that it would have been obvious to one of ordinary skill in the art the time the invention was made to add aluminum hydroxide powder to the adhesive disclosed in Takuman. In paragraph 3 of the office action dated May 16, 2006, examiner takes the position that it would have been obvious to one of ordinary skill in the art the time the invention was made to replace the calcium carbonate powder with aluminum hydroxide powder because Simizu discloses that aluminum hydroxide powder has significant advantages over calcium carbonate powder.

As to Simizu, applicant states that "in the present invention the low modulus and high elongation is not the essential feature," and concludes that "the function and effect of finely divided powder of aluminum hydroxide in Simizu US '140 is quite different from those of the present invention." Examiner respectfully asserts that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Additionally, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a

different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).” MPEP 2144.

Applicant further argues that the “essential difference between Example d and Comparative Example c is whether or not the composition is self-extinguishing.” Examiner agrees that this is one such difference. However, this is not the only difference between the examples and examiner asserts that Simizu clearly recognizes that aluminum hydroxide is critical to the elastomer being self-extinguishing, *and* having high elongation and an extremely low modulus (column 4, lines 34-37). Applicant appears to be arguing the Simizu is not concerned with the effect aluminum hydroxide has elongation and modulus. Examiner respectfully asserts that the comments made on column 4, lines 34-37 suggest otherwise. Additionally, the presence of Table 1, where the modulus and elongation are compared clearly indicate that Simizu recognized the advantageous effects aluminum hydroxide powder has on modulus and elongation. Examiner further asserts that even if Simizu was only concerned with the difference in self-extinguishing properties, one of ordinary skill in the art would have readily recognized the benefits of aluminum hydroxide based on the disclosure of Table 1, and based on said recognized benefits one of ordinary skill in the art would have been motivated to either add aluminum hydroxide to the rubber adhesive of Takuman, or replace the calcium carbonate in Takuman with aluminum hydroxide. The disclosure of Simizu that aluminum hydroxide increases self-extinguishing properties does not negate the other disclosed advantages of aluminum hydroxide.

Applicant argues that the composition of Simizu is quite different from Takuman’s claimed composition. Examiner asserts both compositions are polyorganosiloxane rubber

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adhesive, and because the differences between the compositions are only minor, one of ordinary skill in the art would reasonably expect the aluminum hydroxide powder to have the same beneficial effect on Takuman's composition as said aluminum hydroxide powder has on Simizu's composition. The burden is on the applicant to provide a reason as to why the aluminum hydroxide would not have beneficial effects on the modulus and elongation of Takuman's composition. Applicant argues that "the low modulus and high elongation according to Simizu US '140 are attained by the specific curing mechanism using aminoxy group containing organosilicon compound with silanol group-terminated organopolysiloxane (as disclosed at column 9, lines 29 to 30 of Simizu US '140), rather than by using aluminum hydroxide." Examiner has reviewed applicant's cited text and respectfully asserts that column 9, lines 29-30 says nothing about the low modulus and high elongation relating to the specific curing mechanism. The disclosures on column 4, lines 34-37 and in Table 1 clearly disclose that using aluminum hydroxide in the composition results in high elongation and low modulus.

Applicant argues that Simizu and Takuman having different curing mechanisms but applicant fails to state why the different curing mechanisms preclude the references from being combined as they relate to the rejection at hand.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

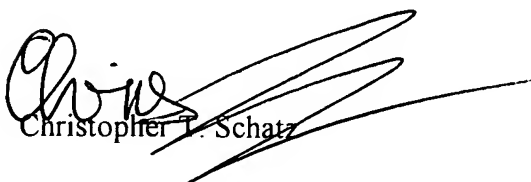
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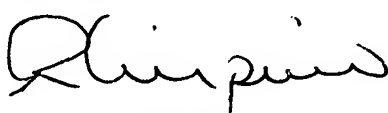
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Christopher T. Schatz


RICHARD CRISPINO
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TECHNOLOGY CENTER 1700